

Attorney's Docket No. 07308.120

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Kamran Loghman-Adham

Appl. No.: 10/036,546

Group Art Unit: 1616

Filed: January 7, 2002

Examiner: Alton Nathaniel Pryor

For: NON-LETHAL TEMPORARY INCAPACITOR
FORMULATION AND NOVEL SOLVENT SYSTEM

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

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This is filed in response to the Restriction and Election Requirement bearing a mail date of January 3, 2003.

Response to Restriction Requirement

In the Restriction Requirement, Examiner has required restriction between the inventions claimed in Group I, namely claims 1-17, drawn to a formulation comprising propylene glycol esters, glycerol tris(2-ethylhexanoate) and a lachrymator agent; Group II, namely claims 15-26, drawn to an aerosol comprising a propellant, propylene glycol dicarprylate/caprates and glycerol; and Group III, namely claims 27-33, drawn to a solvent with a MW of at least 100; all of which are classified in Class 514, Subclasses 506, 724, and 728.

The Examiner has deemed the inventions of Groups I-III to be distinct asserting that a reference reading on one of the inventions may not read on the other two inventions.



The Examiner has further concluded that the restriction requirement is proper since the inventions are distinct and that even though all of the inventions are classified in the identical Class and Subclasses, the field of search may be different.

Applicant respectfully requests reconsideration and withdrawal of this restriction requirement.

According to the MPEP §803, restriction is proper when the inventions are either independent or distinct, **and** there is a serious burden on the examiner. Furthermore, "if the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it included claims to independent or distinct inventions." (first full paragraph on page 800-4, August 2001 edition).

Applicant fails to see the serious burden on the examiner. The three groups all have the exact same classification and the Examiner has not set forth how the fields of search for each may differ or if there is a separate status in the art for each of the listed groups of inventions.

On the other hand, the restriction requirement places a serious financial burden on the Applicant, who is a small entity. Rather than the fees for one application, the Applicant must now pay the fees for three applications. This is very substantial burden, particularly when maintenance fees must be paid.

Accordingly, Applicant respectfully requests that the Examiner reconsider the restriction requirement and withdraw the same if there is no serious burden on the Examiner in conducting the search and examination of all of the claims of this application, either now and/or when the elected claims are allowed.

In accordance with the requirements of 37 C.F.R. 1.143, Applicants hereby provisionally elect to prosecute the claims of Group I, namely claims 1-17, drawn to a formulation comprising propylene glycol esters, glycerol tris(2-ethylhexanoate) and a lachrymator agent. Should the restriction requirement not be withdrawn, applicants

expressly reserves the right to file divisional applications in due course directed to the subject matter of the remaining claims.

Response to Election Requirement

The Examiner has further issued an Election Requirement requiring that a single disclosed species of the "numerous compositions and solvents" disclosed in the application be elected for prosecution.

Applicant likewise does not see the serious burden on the Examiner in conducting a search and examination of the claimed subject matter and thus requests reconsideration of this election requirement.

In accordance with the requirements of 37 C.F.R. 1.146, Applicant hereby elects to prosecute the species of the claims of Group I where the propylene glycol ester is propylene glycol dicaprylate/caprate (claims 2-4) and the lachrymator agent is oleoresin capsicum (claims 8-11). In accordance with the Examiner's instructions, Applicant hereby advises the Examiner that the Applicant further elects to prosecute the species of the claims of Group I wherein the formulation further comprises a propellant (claim 12), a propellant that is miscible in the solvent system (claim 13), and a carbon dioxide propellant (claim 14). Claims 5-7 are directed to the glycerol tris(2-ethylhexanoate) component and are thus also encompassed by this election of species.

Accordingly, claims 1-14 are either generic to or specifically encompass the elected species.

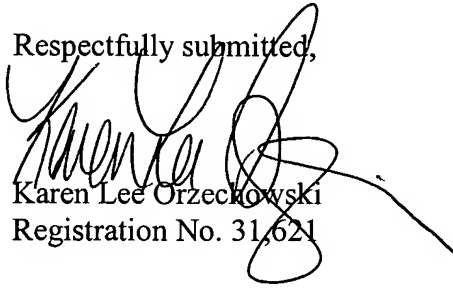
Conclusion

Should the Examiner have any questions, he is requested to contact the undersigned.

It is not believed that extensions of time or fees are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper,

such extensions are hereby petitioned, and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 50-0548 and it is requested that the undersigned be notified in the event of such a charge to the Deposit Account.

Respectfully submitted,


Karen Lee Orzechowski
Registration No. 31,621

Date: January 9, 2003

LINIAK, BERENATO & WHITE
6550 Rock Spring Drive, Suite 240
Bethesda, MD 20817
Telephone: (301) 896-0600
Facsimile: (301) 896-0607

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office at Fax No. (703) 308-4556 on January 9, 2003.

Karen Lee Orzechowski

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner For Patents, Washington, DC 20231, on January 9, 2003.

Karen Lee Orzechowski